

## REMARKS

Reconsideration of the above-identified patent application in view of the proposed amendment above and the remarks below is respectfully requested.

Claims 8-10 and 43 are herein proposed to be canceled in this paper. Claim 44 is herein proposed to be amended. No claims are herein proposed to be added in this paper. Therefore, claims 11-37, 41-42 and 44-47 are pending and are under active consideration.

In the outstanding Office Action, the Patent Office states that “[t]his application contains claims 8-10 drawn to an invention nonelected without traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.”

In reply to the above, Applicants note that claims 8-10 have been canceled in this paper.

Claims 11-37 and 41-47 stand rejected under 35 U.S.C. 103(a) “as being unpatentable over Bone (4,039,078).” In support of the rejection, the Patent Office states the following:

Bone ‘078 discloses a length of continuously connected fastener stock comprising: first and second side members (60A and 60B); and a plurality of cross-links (60C) interconnecting said first and second side members. Bone ‘078 discloses (column 6, lines 17-21 and lines 29-35) that the side members and the cross-links may take many forms such as oval, triangular, octagonal, circular, etc. See Figures 1-9 embodiments.

As admitted by applicant cross-links that have both a flat surface and an arcuate surface are well known in the art. (Figures 1-6 embodiment of the instant application).

Therefore, with respect to the shape and size of the side members and cross-links it would have been an obvious matter of design choice to modify the shape and size of the side members and cross-links in view of the teaching of Bone ‘078 and since such a modification would have involved a mere change in shape and size

of a component. A change in shape and size is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claims 11-18, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 946, 966 (Fed. Cir. 1985).

A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Later in the Office Action, the Patent Office states the following:

Applicant's arguments filed January 26, 2004 have been fully considered but they are not persuasive. As admitted by applicant cross-links and side members that have both a flat surface and an arcuate surface are well known in the art. (Figures 1-6 embodiment of the instant application).

Therefore, with respect to the shape and size of the side members and cross-links it would have been an obvious matter of design choice to modify the shape and size of the side members and cross-links in view of the teaching of Bone '078 and since such a modification would have involved a mere change in shape and size of a component. A change in shape and size is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and *In re Rose*, 105 USPQ 237 (CCPA 1955).

Applicants respectfully traverse the foregoing rejection.

Claim 11, from which claims 16-18 depend, recites “[a] length of continuously connected fastener stock fabricated according to a method comprising the steps of:

(a) providing a rotating molding wheel, said rotating molding wheel being provided with a peripheral impression comprising a pair of peripherally-extending side members interconnected by a plurality of cross-links wherein each of said peripherally-extending side members of said peripheral impression is generally semi-circular in transverse cross-section and wherein each of said cross-links of said peripheral impression is generally semi-circular in transverse cross-section;

(b) extruding molten plastic into the peripheral impression of said rotating molding wheel, with a layer of controlled film overlying the peripheral impression;

(c) allowing the molten plastic to solidify;

(d) using a knife in substantially elliptical contact with the peripheral impression to skive excess plastic from the rotating molding wheel, said knife having a bottom provided with a first cut-out portion aligned with one of said peripherally-extending side members so as to augment the transverse cross-sectional size thereof; and

(e) removing the continuously connected fastener stock thus formed from the rotating molding wheel.”

The Patent Office is apparently arguing that claim 11 is unpatentable because (i) “cross-links that have both a flat surface and an arcuate surface are well known in the art” and (ii) Bone discloses fastener stock having round side members and rectangular cross links but states that “the side members or cross links may take various other shapes such as oval, triangular, octagonal, etc.”

Applicants respectfully disagree with the Patent Office’s conclusion of obviousness and respectfully submit that there is no basis for making the proposed modifications. As noted previously by Applicants, Bone discloses two completely different techniques for fashioning fastener

stock. The first technique, which is shown in Bone in Figs. 1-4 and 49-50 and is described in Bone at col. 4, line 42 through col. 5, line 45, and at col. 12, line 55 through col. 13, line 2, involves punching or forming apertures in an extruded sheet of plastic. As can be appreciated, the fastener stock made by this first technique typically has rectangular side members and rectangular cross-links. The second technique, which is shown in Bone in Figs. 5-10 and 51-54 and is described in Bone at col. 5, line 46 through col. 6, line 35 and at col. 13, lines 3-14, involves injection molding a plurality of separately molded segments and then welding together the separately molded segments. Bone discloses that this second type of fastener attachment stock has round side members and round cross-links (see col. 5, lines 63-65, of Bone) but may have round cross-links and rectangular side members or vice versa (see col. 6, lines 17-21, of Bone) or may have side members or cross-links taking "various other shapes such as oval, triangular, octagonal, etc." (see col. 6, lines 30-32, of Bone).

By contrast, the fastener stock of Figs. 1, 2 and 6 of the present application, upon which the Patent Office is apparently basing its statement that "cross-links that have both a flat surface and an arcuate surface are well known in the art," is made by rotary extrusion molding, a technique that is entirely different from the punching or injection molding techniques disclosed in Bone.

While Applicants acknowledge that claim 11 is a product-by-process claim and that the patentability of the claimed product is based on the product, itself, as opposed to its method of manufacture, Applicants respectfully submit that the Patent Office has not given due weight to the fact that, given the differences in the techniques used to make the various alleged prior art products, there would have been no motivation for one of ordinary skill in the art to have made the modifications needed to arrive at the claimed invention. The Patent Office is apparently arguing that

one could have arrived at the claimed fastener stock by replacing the Bone cross-links with cross-links having both a flat surface and an arcuate surface. However, the issue is not what could have been done but what would have been obvious to one skilled in the art at the time of the invention. Applicants respectfully submit that one of ordinary skill in the art would have had no reason to make the proposed modification. Cross-links having both a flat surface and an arcuate surface are a consequence of the rotary extrusion process used to make fastener stock, said rotary extrusion process involving extruding molten plastic into an impression formed in a mold wheel, the impression typically having an arcuate bottom, and using a knife placed in elliptical contact with the impression to skive excess plastic from the mold wheel. As can be appreciated, as a result of the skiving process, the surface of the molded product opposite to the arcuate bottom has a flat surface. Prior to the present invention, one could not, using rotary extrusion molding, fashion side members that extended beyond the plane of the cross-links.

By contrast, if one were to make fastener stock by injection molding, the skiving process that results in cross-links having a flat surface and an arcuate surface is not used. Moreover, there would have been no reason to injection mold cross-links in the same shape that follows from rotary extrusion molding. Therefore, in view of the different molding techniques involved, it can be seen that there is no basis for the proposed modification.

Moreover, to the extent that the Patent Office appears to be suggesting that the language in Bone that "the side members or cross links may take various other shapes such as oval, triangular, octagonal, etc." renders unpatentable the claimed structure, Applicants respectfully submit that the language in question fails to provide sufficient direction to one of ordinary skill in the art to arrive at the claimed invention. Otherwise, taken to its logical endpoint, the passage in question would

render unpatentable virtually any shape of side member and/or cross-link, a result that would clearly be in error as reflecting an incorrect standard tantamount to a mere invitation to experiment.

Independent claims 12, 14, 19 and 41 are patentable over Bone for at least the same types of reasons given above in connection with claim 11.

Claim 44, which has been re-written herein in independent form and from which claims 45-47 depend, is patentable over Bone for at least the reason that Bone does not teach or suggest fastener stock comprising, among other things, (i) first and second side members wherein said first side member is circular in transverse cross-section; and (ii) cross-links that asymmetrically bisect said first and second side members. In particular, nothing in Bone teaches or suggests asymmetrically bisecting a side member that is circular in transverse cross-section.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

In conclusion, it is respectfully submitted that the present application is in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 9, 2004.

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